

REMARKS

The present amendment is submitted in response to the Office Action dated August 11, 2004, which set a three-month period for response, making this amendment due by November 11, 2004.

Claims 8-13, 14/8, 14/11, 15/8, 15/10, 15/11, 15/13, 16/8, 16/11, and 17-22 are pending in this application.

In the Office Action, the disclosure was objected to for various informalities. Claims 8 and 11 were objected to for various informalities. Claims 8-22 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 8, 9, 12, 14/8, 15/8, and 16/8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,533, 012 to Fulkasawa et al in view of U.S. Patent No. 5,377,194 to Calderbank and U.S. Patent No. 6,256,497 to Chambers. Claims 11, 12, 14/11, 15/11, and 16/11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fulkasawa et al in view of Chambers. Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Fulkasawa et al and Calderbank in view of EP 0,849,965A to Poppen. Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fulkasawa et al in view of Poppen.

The Applicants note with appreciation the allowance of claims 10, 13, 15/10, 15/13, and 17-22, if rewritten in independent form to include the limitations of the base claim and any intervening claims.

In this amendment, page 14 of the specification has been amended to replace "second mobile station 5" with "intermediary station 15".

With regard to the objection under Paragraph 1(a) on page 2 of the Office Action, in the Simultaneous Amendment dated January 19, 2001, the specification was amended on page 13, at line 4, to correct the objected-to text. Please see the Simultaneous Amendment on page 3, the last line after the "Summary of the Invention" insert.

The claims have been amended to address the noted objections and rejections under Section 112, second paragraph.

However, with regard to the rejection under Section 112, second paragraph, raised in Section 4 (b) of the Office Action, the Applicants are unclear as to the stated objection and ask for further clarification before amending claim 11 further.

With regard to the substantive rejections of the claims, the Applicants respectfully disagree that the cited references and reference combinations make obvious the subject matter of the present invention.

The primary reference to Fulkasawa et al discloses a communication system with improved use of the send and return channels. In the send channel, a base station transmits to a plurality of mobile stations. The subject matter of Fulkasawa, in particular, deals with the suppression of interference, which occurs in the return channel between the individual mobile stations. With the subject matter of this reference, the signals to be transmitted in the return channel from the mobile station to the base station are first audio-encoded and subsequently

channel encoded in the mobile station. In the base station, the signals received from the mobile station are then channel decoded and audio decoded. The data decoded in this manner are then further conducted via telephone lines to a switching center 300 (see Figure 1 and column 4, lines 36-38 of Fulkasawa). Fulkasawa fails to disclose any information for the case in which the data further conducted to the switching center 300 is to be transmitted back from the switching station 300 again to the base station 100, in order to send it to a second mobile station (not shown in the reference) and for this purpose, a new audio coding and channel coding is performed.

In addition, the base station 100 in Fulkasawa sends and receives merely in a single telecommunication network by means of the send channel to a plurality of mobile stations and by means of a corresponding return channel for receiving signals from these mobile stations. In contrast to the subject matter of claims 8 and 11 of the present application, the base station 100 of the Fulkasawa reference does NOT operate as an intermediary station, which receives data via a first telecommunication network and further sends it via a second telecommunication network. That is, the base station of Fulkasawa does not operate as a connecting member between to different telecommunication networks.

If the sending of control signals from the base station is known from Fulkasawa in column 19, line 62 to column 20, line 3, as the Examiner maintains, then the teachings of Fulkasawa are counter to those of the present invention, as

defined in claims 8 and 11, specifically, that the signalization data contains information about the type of the encoding of the useful data in a first step.

Likewise, Fulkasawa fails to disclose the feature of claims 8 and 11, whereby the useful data decoded in the second step from the second mobile station are decoded by the second mobile station in dependence on the signalization data received by the second mobile in the first step. The citation noted by the Examiner in the Office Action, specifically, column 25, lines 21-35 of Fulkasawa, discloses that the invention described in the reference is not limited to ADPCM coding of the audio signal. The same transmission modulators and interference suppressors can be used with each type of digital coded signals. This disclosure in Fulkasawa provides no suggestion about the noted control signal mentioned, for example, in column 20, lines 1-2, nor of the feature of claims 8 and 11 of the present application, in which such control data are used in the receiving mobile station for decoding of the received useful data in the first step.

The control signal of Fulkasawa, contrary to claims 8 and 11, are not used for decoding the useful data received by the second mobile station in the first step, rather for suppression of a phase differential between the support generators of the base station and the mobile station (see, for example, column 21, line 66 through column 22, line 6 of Fulkasawa). This process takes place during the transmission of the received signal (see, for example, column 26, line 9-13 of the reference), and therewith, also before the channel decoding and

before the audio decoding, which can be seen in Figure 1 in the order of blocks 214, 215, and 216.

The control signal of Fulkasawa, therefore, has nothing to do with the signalization data of claims 8 and 11.

These features for the sending and evaluation of signalization data, which contain information about the type of the coding of the useful data in the first step, also cannot be found or even derived from the Calderbank or Chambers references.

Because Fulkasawa, in combination with the Calderbank and Chambers references, fails to suggest to the practitioner the present invention as defined in the independent claims, the rejections under Section 103 must be withdrawn. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 932, 933 (Fed. Cir. 1984). Here, the prior art of record fails to provide any such suggestion.

For the reasons set forth above, the Applicants respectfully submit that claims 8-22 are patentable over the cited art. The Applicants further request withdrawal of the rejections under 35 U.S.C. 103 and reconsideration of the claims as herein amended.

In light of the foregoing amendments and arguments in support of patentability, the Applicants respectfully submit that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,



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